

Appl. No. 09/466,996
Amdt. Dated MM/DD/YYYY
Reply to Office Action of 08/13/2003

REMARKS/ARGUMENTS

This Amendment is in response to the Office Action mailed August 13, 2003. In the Office Action, (i) claims 1, 3-4, 6, 13-15, 17, 19, 21-25 and 28-30 were rejected under 35 U.S.C. § 102(e), and (ii) claims 2, 5, 12, 26, 31-32, and 35-36 were rejected under 35 U.S.C. § 103(a). Applicants have added new claims 39-44. Reconsideration in light of the amendments and remarks made herein is respectfully requested.

Allowable Subject Matter

1. Applicants note with appreciation the Examiner's indication of allowable subject matter. The Examiner objects to claims 7-11, 16, 17-18, 20, 27, 33-34, and 37-38 as being dependent on a rejected base claim, but indicates that the claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants have placed claims 7, 16, 17, 20, 27, 33 and 37 in independent form. Thus, claims 7-11, 16-18, 20, 27, 33-34, and 37-38 are in condition for allowance.

Rejection Under 35 U.S.C. § 102

Claims 1, 3-4, 6, 13-15, 17, 19, 21-25 and 28-30 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,215,951 issued to Hailey. Applicants respectfully traverse the rejection. Applicants respectfully traverse the rejection and contend that the Examiner has not met the burden of establishing a prima facie case of anticipation.

To anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Vergegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the...claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989).

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Hailey discloses automatic title or description captioning for a VCR recording. The program title and date are recorded onto the tape as a user-readable display ahead of the desired television program (Hailey, col. 2, lines 32-34). Program titles are broadcast by TV stations. These are decoded and inserted into the directory (Hailey, col. 55, lines 32-35). Hailey does not disclose, inherently or expressly, a title frame including one of customized information and the received program information. Claims 1, 19, 28 and 31 have been amended to provide further specificity to the claim language.

Regarding claims 4, 13, 17, 21-22, 24 and 29-30, the Examiner states that the graphic treatment is considered to be inherent with respect to any on screen display (OSD). Applicants respectfully disagree. The OSD is merely a display of the program on the screen. The OSD does not display a graphic treatment. In contrast, the graphic treatment is a graphic representation of the genre or category data portion of the program information (see, for example, Specification, page 14, lines 5-9; lines 11-12).

Based on the foregoing, Applicants respectfully request that the Examiner withdraw the rejection of claims 1, 3-4, 6, 13-15, 17, 19, 21-25 and 28-30 under 35 U.S.C. § 102(b).

Rejection Under 35 U.S.C. § 103

1. Claims 5, 31-32, and 35-36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hailey. In addition, claims 2, 26 and 36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hailey in view of U.S. Patent No. 5,469,224 issued to Her and claim 12 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Hailey in view of U.S. Patent No. 6,487,362 issued to Yuen et al. ("Yuen"). Applicants respectfully traverse the rejection and contend that the Examiner has not met the burden of establishing a *prima facie* case of obviousness.

With regard to claims 5, 31-32, and 35-36, the Examiner takes official notice that genre information is known in the art. However, Hailey does not disclose selecting a graphic treatment

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as discussed under the § 102(b) discussion above. Therefore, Hailey does not disclose, suggest, or render obvious selecting a graphic treatment corresponding to genre information.

As to claims 2, 26 and 36, Her discloses recording signal selection method for video titling. A recording signal selection is turned on or off in order to select either a superimposed signal or a standard signal as a recording signal (Her, col. 2, lines 45-48).

The Examiner states that Her teaches providing a user the option, through a switch to either provide a title to the recording or not (Office Action, page 5, paragraph 5). Applicants respectfully disagree. First, the switch is used to select either a superimposed signal or a standard signal, not select either recording title or not. Second, the switch is used when not in the state of a titling mode (Her, col. 2, lines 47-48). Third, the switch is not used to select generating and recording a title frame.

With regard to claim 12, Yuen discloses enhancing operations of video tape cassette players. If no title is detected from the broadcast signals and if no title is entered by a user, then a default title is inserted into the directory (Yuen, col. 110, lines 16-18).

Yuen does not disclose, suggest, or render obvious a title frame including one of customized information and the received program information as discussed above. Furthermore, Yuen merely discloses a default title inserted into the directory, not a default title frame.

Accordingly, Hailey, Her, and Yuen, either taken alone or in any combination, do not disclose, suggest, or render obvious selecting a graphic treatment, recording a title frame, and the title frame including one of customized information and the received program information. As demonstrated above, a *prima facie* case of obviousness has not been established.

Applicants respectfully request that the Examiner withdraw the rejection of claims 5, 31-32, and 35-36 under 35 U.S.C. § 103(a).

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Conclusion

Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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